

Remarks/Arguments

Applicants note that the Office Action stated: that applicant's election of invention of Group 1, Claims 1 to 4 and 6 to 8, species epoxy compound (a₃) of the polyhydric polyol in the reply filed on February 12, 2008 is acknowledged; and that, because applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse.

Claims 1 to 4 and 6 to 8 have been rejected under 35 U.S.C. 112, first paragraph. In response to this rejection, applicants have amended Claim 1 in this Amendment.

The Office Action stated: that the specification, while being enabling for an amine-added epoxy resin (A) obtained by reacting an epoxy resin (a₁) with an epoxy compound (a₃) of a polyhydric polyol to form a modified epoxy resin and then by reacting the modified epoxy resin with an amino group-containing compound (a₆) does not reasonably provide enablement for the amine-added epoxy resin (A) obtained by reacting an epoxy resin (a₁) with an epoxy compound (a₃) of a polyhydric polyol; that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims; that the above claims recite that an amine-added epoxy resin (A) is obtained by reacting an epoxy resin (a₁) with one or more modifying agent(s) where one of the modifying agents (the elected species) is an epoxy compound (a₃) of a polyhydric polyol; that because of the breadth of the claims, the above claimed subject matter can be interpreted as that the amine-added epoxy resin (A) is obtained by the reaction of the epoxy resin (a₁) with the epoxy compound (a₃) of the polyhydric polyol, for example; that the specification does not enable such an interpretation; and that the specification clearly discloses in the first full paragraph of page 13 that "the amino group-containing compound (a₆) is added to the modified epoxy resin to obtain an amine-added epoxy resin (A)", and in paragraph crossing pages 12 and 13 that the modified epoxy resin is obtained by reacting the epoxy resin (a₁) with one or more of the modifying agents where one of the modifying agents (the elected species) is

an epoxy compound (a₃) of a polyhydric polyol. In response, applicants have amended Claim 1 to read, in pertinent part, "obtained by reacting an epoxy resin (a₁) with a modifying agent consisting of an epoxy compound (a₃) of a polyhydric polyol and with a polyphenol compound (a₅) to form a modified epoxy resin, followed by adding an amino group-containing compound (a₆) to the modified epoxy resin for reacting". Support for this amendment to Claim 1 is present in the descriptions on line 12 on page 12 to line 9 on page 13, Preparation Examples 1 to 4, and lines 9 to 19 on page 19 in the specification. And, Claims 2 to 4 and 6 to 8 depend either directly or indirectly on amended Claim 1.

Thus, applicants assert that this rejection of Claims 1 to 4 and 6 to 8 under 35 U.S.C. 112, first paragraph, presently should be withdrawn.

Claims 1 to 3 have been rejected under 35 U.S.C. 112, first paragraph. In response, applicants have amended Claim 1 in this Amendment.

The Office Action stated: that because the specification, while being enabling for the coating of the cationic electrodeposition coating composition by an electrodeposition coating (third full paragraph in page 19), does not reasonably provide enablement for the coating of the cationic electrodeposition coating composition by any other coating technique, such as by coil coating; that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims; that the above claims recite that the method comprises coating of the cationic electrodeposition coating composition onto the substrate; that because of the breadth of the claims, the above claimed subject matter can be interpreted as that the cationic electrodeposition coating composition can be coated by coil coating, for example; and that the specification does not enable such an interpretation. In response, applicants have amended Claim 1 to read, in pertinent part, "which method comprises coating a cationic electrodeposition coating composition onto a substrate by an electrodeposition coating". And, Claims 2 and 3 depend either directly or indirectly on amended Claim 1.

Thus, applicants assert that this rejection of Claims 1 to 3 under 35 U.S.C. 112, first paragraph, presently be withdrawn.

Claims 1 to 4 and 6 to 8 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, applicants have amended Claim 1 in this Amendment.

The Office Action stated: that Claim 1 is indefinite and confusing since the claim recites the reaction of the epoxy resin (a₁) with one or more modifying agents where one of the modifying agents (the elected species) is an epoxy compound (a₃) of a polyhydric polyol to form an amine-added epoxy resin; and that it is not clear how the formed amine-added epoxy resin contains the added amine when the recited reaction is from the non-amine-containing modifying agent. In response, applicants have amended Claim 1 to read, in pertinent part, "obtained by reacting an epoxy resin (a₁) with a modifying agent consisting of an epoxy compound (a₃) of a polyhydric polyol and with a polyphenol compound (a₅) to form a modified epoxy resin, followed by adding an amino group-containing compound (a₆) to the modified epoxy resin for reacting". Support for this amendment to Claim 1 is present in the descriptions on line 12 on page 12 to line 9 on page 13, Preparation Examples 1 to 4, and lines 9 to 19 on page 19 in the specification.

The Office Action stated: that depending Claims 2 to 4 and 6 to 8 are indefinite for their dependence upon an indefinite Claim 1. Claims 2 to 4 and 6 to 8 depend either directly or indirectly on Claim 1 which has been amended herein.

The Office Action stated: that, further, in Claim 4, the recitation "after starting of energizing" is either confusing as whether it is another step of Claim 1 or is lacking antecedent basis. In response, applicants have amended Claim 4 to read, in pertinent part, "wherein a coating film formed in one minute from starting of energizing on carrying out the electrodeposition coating ~~one minute after starting of energizing on the electrodeposition~~

coating, a resulting coating film has". Support for this amendment to Claim 4 is present in the descriptions in lines 9 to 19 on page 19 in the specification.

The Office Action stated: that in Claim 7, the same is applied to Claim 4. In response, applicants have amended Claim 7 to read, in pertinent part, "wherein a coating film formed in one minute from starting of energizing on carrying out the electrodeposition coating ~~one minute after starting of energizing on the electrodeposition coating, a resulting coating film has~~". Support for this amendment to Claim 7 is present in the descriptions in lines 9 to 19 on page 19 in the specification.

The Office Action stated: that in Claim 8, the same is applied to Claim 4. In response, applicants have amended Claim 8 to read, in pertinent part, "wherein a coating film formed in one minute from starting of energizing on carrying out the electrodeposition coating ~~one minute after starting of energizing on the electrodeposition coating, a resulting coating film has~~". Support for this amendment to Claim 8 is present in the descriptions in lines 9 to 19 on page 19 in the specification.

Thus, applicants request that this rejection of Claims 1 to 4 and 6 to 8 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention presently be withdrawn.

Applicants note that the Office Action stated: that Claims 1 to 4 and 6 to 8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraphs, set forth in the subject Office Action.

Applicants note that the Office Action stated: that the following is statement of reasons for the indication of allowable subject matter: Because the prior art references do not disclose in a coating film-forming method the step of electrodeposition coating a cationic electrodeposition coating composition onto a substrate followed by heat curing to form a cured electrodeposition coating film, where the cationic electrodeposition coating composition containing the recited curing agent and a base resin consisting of an amine-added epoxy resin

(A) obtained by reacting an epoxy resin (a₁) with an epoxy compound (a₃) of a polyhydric polyol to form a modified epoxy resin, and then by reacting the modified epoxy resin with an amino group containing compound (a₆)

Reconsideration, reexamination, and allowance of the claims are requested.

Respectfully submitted,

5/31/08
Date

Fisher, Christen & Sabol
1725 K St. NW
Suite 1108
Washington, DC 20006
Tel.: 202-659-2000
Fax: 202-659-2015
fcsabol@aol.com

Kara M. Armstrong
Kara M. Armstrong
Reg. No. 38,234

Certificate of Mailing

I hereby certify that this Amendment dated May 31, 2008 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Kara M. Armstrong
FISHER, CHRISTEN & SABOL
1725 K St. N.W.
Suite 1108
Washington, D.C. 20006